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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,938	06/27/2001	Raouf Botros	SDP273PA	6293

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Law Office of Barbara Joan Haushalter
228 Bent Pines Court
Bellefontaine, OH 43311

EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,938

Applicant(s)

BOTROS ET AL. *TC-4*

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 5-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polymer which is ethoxylated polyethyleneimine, does not reasonably provide enablement for any type of polymer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Case law holds that applicant's specification must be "commensurately enabling [regarding the scope of the claims]" *Ex Parte Kung*, 17 USPQ2d 1545, 1547 (Bd. Pat. App. Inter.

1990). Otherwise **undue experimentation** would be involved in determining how to practice and use applicant's invention. The test for undue experimentation as to whether or not all compounds within the scope of claims 1 and 5-10 can be used as claimed and whether claims 1 and 5-10 meet the test is stated in *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. Inter. 1986) and *In re Wands*, 8 USPQ2d 1400, 1404 (Fed.Cir. 1988). Upon applying this test to claims 1 and 5-10, it is believed that undue experimentation **would** be required because:

(a) *The quantity of experimentation necessary* is **great** since claims 1 and 5-10 read on any type of polymer such as polymers of (meth)acrylic esters or (meth)acrylic acids, polyurethane, polyester, polyamide, polycarbonate, polyethylene, etc.

(b) There is **no direction or guidance presented** for making an ink comprising any type of polymer such as polymers of (meth)acrylic esters or (meth)acrylic acids, polyurethane, polyester, polyamide, polycarbonate, polyethylene, etc.

(c) There is an **absence of working examples** concerning making coating compositions comprising any type of polymer such as polymers of (meth)acrylic esters or (meth)acrylic acids, polyurethane, polyester, polyamide, polycarbonate, polyethylene, etc.

In light of the above factors, it is seen that undue experimentation would be necessary to make and use the invention of claims 1 and 5-10.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 6-7 contain the trademark/trade name Surfynol. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe surfactants and, accordingly, the identification/description is indefinite.

(b) Claim 15 recites that the thickener is Guar. The scope of the claim is confusing given the capitalization of "Guar". Does this refer to a product known under the trademark/tradename Guar? If so, see paragraph (a) above. If not, does this refer to guar gum? Clarification is requested.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5, 13, 15, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ooms (U.S. 4,476,031).

Ooms discloses composition comprising ethoxylated polyethyleneimine, electrolyte, cationic surfactant, guar gum, water, biocide, pH buffer, and ammonium sulfate (col.3, line 63, col. 5, line 29, col.7, lines 50-53, col.6, lines 56-58 and 63-66, col.8, line 67-col.9, line 3).

While there is no disclosure that the composition is “for application on an ink jet printed porous substrate for improving the waterfastness of the ink jet image” (claim 1) or “used as a pre-coat treatment prior to ink jet imaging the substrate” (claim 20) as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the

prior art composition and further that the prior art composition identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Ooms anticipates the present claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-3, 5-7, 9, 13-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '789 (U.S. 5,730,789) in view of either Gundlach et al. (U.S. 6,258,873) or Moffatt et al. (U.S. 6,323,257).

Botros '789 discloses ink composition comprising ethoxylated polyethyleneimine, less than 1% ammonium salt, dimethylethanolamine, water, biocide, surfactant, i.e. acetylenic diol, and lower aliphatic alcohol (col.2, lines 25-27, 43-49, and 59-61, col.3, lines 1-4 and 20-47).

From example III, it is calculated that the ink comprises approximately 8% ethoxylated polyethyleneimine, 0.8% dimethylethanolamine, and 0.09% surfactant.

The difference between Botros '789 and the present claimed invention is the requirement in the claims of thickener.

Gundlach et al. which is drawn to ink jet inks, disclose the use of 0.1-5% viscosity building compound such as guar gum (col.17, lines 53-59 and col.18, lines 7-12).

Alternatively, Moffatt et al. (U.S. 6,323,257), which is drawn to ink jet inks, disclose the use of up to 3% guar gum in order to improve optical density and print quality of the ink (col.17, lines 27-31 and 34).

In light of the motivation for using thickener, i.e. guar gum, disclosed by either Gundlach et al. or Moffatt et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use guar gum in the ink jet ink of Botros '789 in order to produce ink

with desired viscosity, or alternatively, improved optical density and print quality, and thereby arrive at the claimed invention.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '789 in view of either Gundlach et al. or Moffatt et al. as applied to claims 1-3, 5-7, 9, 13-18, and 20 above, and further in view of Bates et al. (U.S. 5,958,999).

The difference between Botros '789 in view of either Gundlach et al. or Moffatt et al. and the present claimed invention is the requirement in the claims of specific amount of ethoxylated polyethyleneimine.

It is noted that the examples of Botros '789 disclose the use of 8% ethoxylated polyethyleneimine which falls outside the amount presently claimed. However, these are but a few preferred embodiments of Botros '789.

Bates et al., which is drawn to ink jet ink, disclose the use of 0.2-5% ethoxylated polyethyleneimine in order to promote waterfastness of images with detrimentally affecting the stability of the ink (col.6, lines 27-38).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use ethoxylated polyethyleneimine in Botros '789 in amounts, including that presently claimed, in order to produce stable ink that produces waterfast images, and thereby arrive at the claimed invention.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '789 in view of either Gundlach et al. or Moffatt et al. as applied to claims 1-3, 5-7, 9, 13-18, and 20 above, and further in view of Kashiwazaki et al. (U.S. 6,011,098).

The difference between Botros '789 in view of either Gundlach et al. or Moffatt et al. and the present claimed invention is the requirement in the claims of specific amount of Surfynol.

It is noted that Botros '789 discloses the use of surfactant such as acetylene glycol, i.e. Surfynol, and that the examples of Botros '789 disclose the use of 0.09% surfactant, which falls outside the amount presently claimed. However, these are but a few preferred embodiments of Botros '789. A fair reading of the reference as a whole discloses that there is no limitation with respect to the amount of surfactant. Further, it is well known that surfactants such as Surfynol are used to control the surface tension of ink.

Kashiwazaki et al., which is drawn to ink jet inks, and disclose the use of 0.01-5% acetylene glycol (i.e. Surfynol) in order to produce ink with specific surface tension so that the ink possess good wetting properties and therefore print properly from printer (col.8, lines 29-47).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use surfactant in Botros '789 in amounts, including that presently claimed, in order to produce ink with good wetting properties and thus good printing properties, and thereby arrive at the claimed invention.

13. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '789 in view of either Gundlach et al. or Moffatt et al. as applied to claims 1-3, 5-7, 9, 13-18, and 20

above, and further in view of Kashiwazaki et al. (U.S. 6,011,098) and Kitamura et al. (U.S. 6,110,315).

The difference between Botros '789 in view of either Gundlach et al. or Moffatt et al. and the present claimed invention is the requirement in the claims of amount of dimethylethanolamine and pH of ink.

It is noted that the examples of Botros '789 disclose the use of 0.8% dimethylethanolamine that falls outside the amount presently claimed. However, these are but a few preferred embodiments of Botros '789. A fair reading of the reference as a whole discloses that there is no limitation with respect to the amount of dimethylethanolamine.

Kashiwazaki et al., which is drawn to ink jet inks, disclose that inks typically possess pH of 7-10 in order to ensure storage stability of the ink and to prevent the ink from corroding printer (col.7, lines 26-32).

Kitamura et al., which is drawn to ink jet inks, disclose that dimethylethanolamine is known as a pH adjustor.

In light of the above, and given that the pH of the ink depends not only on dimethylethanolamine but also on the other ingredients present in the ink, it therefore would have been obvious to one of ordinary skill in the art to choose amounts of dimethylethanolamine, including those presently claimed, in Botros '789 in order to control pH of the ink to values including those presently claimed in order to produce ink with good storage stability that does not corrode the printer, and thereby arrive at the claimed invention.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '789 in view of either Gundlach et al. or Moffatt et al. as applied to claims 1-3, 5-7, 9, 13-18, and 20 above, and further in view of Hayes (U.S. 4,150,997).

The difference between Botros '789 in view of either Gundlach et al. or Moffatt et al. and the present claimed invention is the requirement in the claims of fluorescent dye.

Botros '789 discloses the use of dyes, however, there is no disclosure of fluorescent dyes as presently claimed.

Hayes, which is drawn to ink jet inks, disclose the use of fluorescent dyes in order to improve the contrast between the writing medium and the ink (col.2, lines 14-16).

In light of the motivation for using fluorescent dye disclosed by Hayes as described above, it therefore would have been obvious to one of ordinary skill in the art to use fluorescent dye in the ink of Botros '789 in order to improve the contrast between the writing medium and the ink, and thereby arrive at the claimed invention.

15. Claims 1-7, 9-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '512 (U.S. 6,280,512) in view of either Gundlach et al. (U.S. 6,258,873) or Moffatt et al. (U.S. 6,323,257).

Botros '512 discloses ink composition comprising 1-10% ethoxylated polyethyleneimine, less than 1% ammonium salt, dimethylethanolamine, water, biocide, surfactant, i.e. acetylenic diol, and lower aliphatic alcohol (col.1, lines 47-57, col.2, lines 21-28, 36-41).

From example 10, it is calculated that the ink comprises approximately 2.35% dimethylethanolamine and 0.4% surfactant.

Although there is no explicit disclosure of the pH of the ink, given that the ink comprises amount of dimethylethanolamine as presently claimed, it is clear that the ink would intrinsically possess pH as presently claimed.

The difference between Botros '512 and the present claimed invention is the requirement in the claims of thickener.

Gundlach et al. which is drawn to ink jet inks, disclose the use of 0.1-5% viscosity building compound such as guar gum (col.17, lines 53-59 and col.18, lines 7-12).

Alternatively, Moffatt et al. (U.S. 6,323,257), which is drawn to ink jet inks, disclose the use of up to 3% guar gum in order to improve optical density and print quality of the ink (col.17, lines 27-31 and 34).

In light of the motivation for using thickener, i.e. guar gum, disclosed by either Gundlach et al. or Moffatt et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use guar gum in the ink jet ink of Botros '512 in order to produce ink with desired viscosity, or alternatively, improved optical density and print quality, and thereby arrive at the claimed invention.

16. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '512 in view of either Gundlach et al. or Moffatt et al. as applied to claims 1-7, 9-18, and 20 above, and further in view of Kashiwazaki et al. (U.S. 6,011,098).

The difference between Botros '512 in view of either Gundlach et al. or Moffatt et al. and the present claimed invention is the requirement in the claims of specific amount of Surfynol.

It is noted that Botros '512 discloses the use of surfactant such as acetylene glycol, i.e. Surfynol, and that the examples of Botros '512 disclose the use of 0.4% surfactant, which falls outside the amount presently claimed. However, these are but a few preferred embodiments of Botros '512. A fair reading of the reference as a whole discloses that there is no limitation with respect to the amount of surfactant. Further, it is well known that surfactants such as Surfynol are used to control the surface tension of ink.

Kashiwazaki et al., which is drawn to ink jet inks, and disclose the use of 0.01-5% acetylene glycol (i.e. Surfynol) in order to produce ink with specific surface tension so that the ink possess good wetting properties and therefore print properly from printer (col.8, lines 29-47).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use surfactant in Botros '512 in amounts, including that presently claimed, in order to produce ink with good wetting properties and thus good printing properties, and thereby arrive at the claimed invention.

17. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Botros '512 in view of either Gundlach et al. or Moffatt et al. as applied to claims 1-7, 9, 13-18, and 20 above, and further in view of Hayes (U.S. 4,150,997).

The difference between Botros '512 in view of either Gundlach et al. or Moffatt et al. and the present claimed invention is the requirement in the claims of fluorescent dye.

Botros '512 discloses the use of dyes, however, there is no disclosure of fluorescent dyes as presently claimed.

Hayes, which is drawn to ink jet inks, disclose the use of fluorescent dyes in order to improve the contrast between the writing medium and the ink (col.2, lines 14-16).

In light of the motivation for using fluorescent dye disclosed by Hayes as described above, it therefore would have been obvious to one of ordinary skill in the art to use fluorescent dye in the ink of Botros '512 in order to improve the contrast between the writing medium and the ink, and thereby arrive at the claimed invention.

18. Claims 1-5, 13, 15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki et al. (U.S. 5,990,201) in view of Bates et al. (U.S. 5,958,999).

Miyazaki et al. disclose ink composition comprising 0.1-10% polymer, pH modifier, guar gum, 0.05-7% surfactant, water, biocide, and fluorescent dye (col.3, lines 36-43, col.14, lines 30 and 40-42, col.4, lines 65-col.5, line 10, col.5, lines 13-15, 52-53, and 65, and col.6, lines 11-12).

The difference between Miyazaki et al. and the present claimed invention is the requirement in the claims of (a) ammonium salt and (b) specific type of polymer.

With respect to difference (a), Bates et al., which is drawn to inks, disclose the use of ammonium salt such as ammonium sulfate in order to enhance the waterfastness of the ink (col.5, lines 58-61).

In light of the motivation for using ammonium salt disclosed by Miyazaki et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use ammonium salt in the ink of Miyazaki et al. in order to produce waterfast ink, and thereby arrive at the claimed invention.

With respect to difference (b), Bates et al. disclose the use of 0.02-5% ethoxylated polyethyleneimine in order to improve the waterfastness of the ink without detrimentally affecting the stability of the ink (col.6, lines 27-38).

In light of the motivation for using ethoxylated polyethyleneimine disclosed by Bates et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polymer in the ink of Miyazaki et al. in order to produce ink with good waterfastness and stability, and thereby arrive at the claimed invention.

19. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki et al. in view of Bates et al. as applied to claims 1-5, 13, 15, and 18-20 above, and further in view of Kashiwazaki et al. (U.S. 6,011,098).

The difference between Miyazaki et al. in view of Bates et al. and the present claimed invention is the requirement in the claims of specific type of surfactant.

Miyazaki et al. disclose the use of surfactant, however, there is no disclosure of the use of Surfynol, i.e. acetylene glycol, surfactant as presently claimed.

Kashiwazaki et al. disclose the use of 0.01-5% surfactant such as acetylene glycol in order to produce ink with specific surface tension so that the ink possesses good wetting properties and therefore will print properly. Kashiwazaki et al. also disclose the equivalence and interchangeability between surfactant such as polyoxyalkylene ether as disclosed by Miyazaki et al. with acetylene glycol surfactant (col.8, lines 29-7).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use acetylene glycol surfactant in the ink of Miyazaki et al., and thereby arrive at the claimed invention.

20. **NOTE:** While there is no disclosure in Botros '789, Botros '512, or Miyazaki et al. that the composition is "for application on an ink jet printed porous substrate for improving the waterfastness of the ink jet image" (claim 1) or "used as a pre-coat treatment prior to ink jet imaging the substrate" (claim 20) as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art composition (combination of references),

which meets the limitations of the present claims, is capable of performing the recited purpose or intended use.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kan et al. (U.S. 4,838,940) disclose ink comprising pH adjustor, electrolyte, guar gum, and surfactant, however, there is no disclosure of ethoxylated polyethyleneimine.

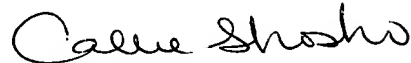
Beach et al. (U.S. 5,352,283) disclose ink comprising ethoxylated polyethyleneimine, water, biocide, pH adjustor, lower aliphatic alcohol, however, there is no disclosure of thickener, electrolyte, or surfactant as presently claimed.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1714

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Examiner
Art Unit 1714

CS
10/4/02